

REMARKS

Claims 6 through 10 are pending in this Application. Claim 6 has been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment is apparent throughout the originally filed disclosure noting, for example, the previously presented claims. Further, Applicant notes that the amendment to claim 6 was made merely to rewrite the claim in independent form and to address the objection to the phrase “an appropriate amount.” Accordingly, no new matter is introduced.

Claims 1 and 2 were objected to for informalities.

In the statement of the objection, the Examiner asserted that the phrase “an appropriate amount” is not clear, (Office Action, page 3). Specifically, it was asserted that it was not clear “what the actual number is,” (*Id.*). Further, the Examiner suggested using a different claim format. These objections are traversed.

Initially, Applicant notes that claims 1 and 2 have been withdrawn; however, claim 6 has been recast into independent form. Accordingly, and in order to expedite prosecution, Applicant has removed reference to the objected phrase “an appropriate amount,” and replaced it with the phrase “a predetermined amount,” which has been well-settled as permissible. *See, e.g., Abbott Labs. v. Syntron Bioresearch, Inc.*, 334 F.3d 1343, 1348-1353 (Fed. Cir. 2003); *Zodiac Pool Care, Inc. v. Hoffinger Indus., Inc.*, 206 F.3d 1408, 1413-1415 (Fed. Cir. 2000).

Applicant, therefore, submits that the imposed objections to claims 1 and 2 are not applicable to claims 6 through 10 and, hence, the imposed objections should be withdrawn.

Claims 6 through 10 were rejected under 35 U.S.C. § 103(a) for obviousness predicated upon *Tanaka et al.* (US 6,391,460), *Kenichi et al.* (JP 2001-192482), and/or *Yasuhisa et al.* (JP 07-026052), in view of *Sonol et al.* (US 5,446,081), and further in view of *Blenner et al.* (US 4,394,205).

In the statement of the rejection, the Examiner accurately admitted that *Tanaka et al.*, *Kenichi et al.*, and *Yasuhisa et al.*, whether taken alone or in combination, fail to teach or suggest, a vulcanized fluoro rubber provided by vulcanizing a composition comprising: 100 parts by mass of mixture in which a raw fluoro rubber (A) in which a predetermined amount of vulcanizing agent has been previously compounded **and a raw fluoro rubber (B) in which the vulcanizing agent is not compounded are mixed at a rate of 8/2 to 3/7,**” (See Office Action, page 6). In an attempt to cure this deficiency, the Examiner argued that a combination of *Sonol et al.* and *Blenner et al.* teach “[t]wo (different type) fluororubbers such as unvulcanized fluororubber/vulcanized fluororubber or solid fluororubber/liquid fluororubber can be bonded and compounded together,” (*Id.*). Indeed, a complete reading of *Sonol et al.* compels the conclusion that *Sonol et al.* teach away from the claimed invention. Furthermore, *Blenner et al.* fails to teach, or even remotely suggest, the aforementioned features. Therefore, this rejection is traversed.

It is well-settled that a reference must be considered in its entirety, i.e., as a whole including those portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). A reference is considered to teach away when a person of ordinary skill, upon reading the reference, “would be led in a direction divergent from the path that was taken by the applicant.” *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877 (Fed. Cir. 1998) (citing *In re Gurley*, 27 F.3d 551, 533 (Fed. Cir. 1994)). In this manner, it “is

impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *See In re Wesslau*, 147 U.S.P.Q. 391 (C.C.P.A. 1965).

With these legal tenants in mind, *Sonol et al.* unambiguously disclose “a composition for low hardness, fluorine-containing rubber, **a liquid fluorine-containing rubber**, and aliphatic amine having an alkyl group having at least 8 carbon atoms and a perfluoropolyether,” (Col. 2, lines 6-11). Applicant, however, particularly disclosed that “as a method of lowering the hardness of the fluoro rubber, while preventing bleeding of the plasticizer, a method of compounding **a liquid rubber composition instead of the plasticizer is well-known . . .** [h]owever, in a case of the application of hot-press cushion material, **the fluoro rubber compounding the liquid rubber is not preferable because it is expected that the liquid rubber bleeds at high temperature under high pressure,**” (See, e.g., Applicants’ Specification, Page 2, lines 23-33). Therefore, the composition of *Sonoi et al.* causes, for example, a printed circuit board being hot-pressed to be contaminated by bleeding liquid rubber, which makes the composition of *Sonoi et al.* unsuitable for “[a] hot-press cushion material,” as is positively claimed. Accordingly, a person of ordinary skill, upon reading *Sonoi et al.*, would be led in a direction divergent from the path taken by Applicant and, therefore, is not a proper reference from which to base an obviousness rejection. *See Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, supra.*

Furthermore, *Blenner et al.* disclose a method for bonding unvulcanized fluorinated elastomers to vulcanized non-fluorinated elastomers via a fluorinated elastomer adhesive, (See, e.g., Abstract; Col. 1, lines 9-14; Col. 1, lines 41-56). The fluorinated elastomers which can be bonded in accordance with the disclosed method are fluorocarbon and fluoro-silicone elastomers,

(See Col. 1, lines 56-58). The vulcanized elastomeric component may include any known natural rubber or synthetic rubber stock, (See Col. 2, lines 14-21). It is noted that with respect to both the unvulcanized fluorinated elastomer and the vulcanized elastomer component, “the described elastomer is fully kneaded with conventional compounding ingredients, such as . . . vulcanization agents,” (See Col. 2, lines 22-28). As such, *Blenner et al.* merely teaches the use of one fluoro rubber and, thereby, similarly fails to teach, or even remotely suggest, a mixture of raw fluoro rubber with a predetermined amount of vulcanizing agent being previously compounded and a raw fluoro rubber in which vulcanizing agent is not compounded, much less in the manner claimed.

Moreover, the Examiner is reminded that the Office is required to consider patentability of an application “as claimed,” not as what the Examiner considers the “gist” of what is being claimed. See, e.g., 37 C.F.R. § 1.104. To this end, it is as impermissible as it is improper to ignore qualifiers in the claims. See *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14 (Fed. Cir. 2000) (holding that the district court “cannot read the qualifier ‘help’ out of the definition of ‘help access window’”). As such, the Office Action failed to specifically address the various mixture ratios and average molecular weight that were particularly claimed by Applicants. The bottom line is that the Examiner has not discharged the judicially imposed initial burden of establishing a *prima facie* case for obviousness by indentifying wherein the applied references disclose a hot-press cushion material comprising “a vulcanized fluoro rubber provided by vulcanizing a composition comprising: **100 parts by mass of mixture** in which a raw fluoro rubber (A) in which a predetermined amount of vulcanizing agent has been previously compounded and a raw fluoro rubber (B) in which the vulcanizing agent is not compounded **are mixed at a rate of 8/2 to 3/7, and 1 to 10 parts by mass of an acid acceptor and 0 to 5 parts by mass of another compounding agent which is compounded as needed, wherein number average**

molecular weight of each of said raw fluoro rubber (A) and said raw fluoro rubber (B) is 3.5×10^4 to 2.0×10^5 . See *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984). Rather than comply with this judicial requirement, the Office Action distorted the claims by improperly distilling the subject matter down to a “gist” or “thrust.” This approach is legally erroneous, because it ignores the **factual** requirements of 35 U.S.C §103(a). *W.L. Gore Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983) (holding that restricting the consideration of the claims and disregarding other limitations resulted in treating the claims as though they read differently than allowed); *Bausch & Lomb v. Barnes Hind/Hydrocurve*, 796 F.2d 443, 449 (Fed. Cir. 1986). The Office is required to view the claimed invention “as a whole.” See, e.g., *Jones v. Hardy*, 727 F.2d 1524, 1527-28 (Fed. Cir. 1984). As a cautionary note, distilling the invention down to a “gist” or “core” is a superficial mode of analysis that disregards elements of the whole. That is, it disregards the express claim limitations that the product be “a vulcanized fluoro rubber provided by vulcanizing a composition comprising: **100 parts by mass of mixture** in which a raw fluoro rubber (A) in which a predetermined amount of vulcanizing agent has been previously compounded and a raw fluoro rubber (B) in which the vulcanizing agent is not compounded **are mixed at a rate of 8/2 to 3/7**, and **1 to 10 parts by mass of** an acid acceptor and **0 to 5 parts by mass of** another compounding agent which is compounded as needed, wherein **number average molecular weight** of each of said raw fluoro rubber (A) and said raw fluoro rubber (B) is 3.5×10^4 to 2.0×10^5 . See also *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572 (Fed.Cir.1984).

Accordingly, even if the teachings of *Tanaka et al.*, *Kenichi et al.*, *Yasuhisa et al.*, *Sonol et al.*, and *Blenner et al.* are combined, and Applicant does not agree that the requisite reasoning

for combining the applied art has been established, the claimed subject matter would still not result. See *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988). Applicant, therefore, submits that the imposed rejection of claims 6 through 10 under 35 U.S.C. § 103(a) for obviousness predicated upon *Tanaka et al.*, *Kenichi et al.*, and/or *Yasuhisa et al.*, in view of *Sonol et al.*, and further in view of *Blenner et al.*, is not factually or legally viable and, hence, solicits withdrawal thereof.

Conclusion

Based upon on the arguments submitted, *supra*, Applicant submits that the imposed rejections of record have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9954 so that such issues may be resolved as expeditiously as possible.

The Director is hereby authorized to charge payment of any fees associated with this communication or credit any overpayment to Deposit Account 504213, including any filing fees under 37 C.F.R. § 1.16 for presentation of extra claims and any patent application processing fees under 37 C.F.R. § 1.17.

Respectfully Submitted,

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August 13, 2009
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